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REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
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EXPEDITED PROCEDURE
GROUP 2823
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64059

Shigeo ISHIKAWA

Appln. No.: 09/832,093

Group Art Unit: 2823

Confirmation No.: 8684

Examiner: Nguyen, Khiem D.

Filed: April 11, 2001

For: FILM FORMING METHOD IN WHICH FLOW RATE IS SWITCHED

TECHNOLOGY CENTER 2800

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1/28/03
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REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

ATTN: BOX AF
Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 28, 2002, please consider the following remarks.

REMARKS

Claims 1-14 are all the claims pending in the application.

I. Response to Claim Rejections Under 35 U.S.C. § 112, 1st paragraph

Claims 1 and 8 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. Specifically, the Examiner asserts that the recitation "while continuing to supply the reaction gas at said first flow rate continues" in claim 1, lines 5-6 and claim 8, line 5-6 is new matter.

Applicants respectfully traverse the rejection and submit that the present specification on page 10, lines 3-7, and Figures 1A and 1B provides support for the claimed process limitation of (a) starting a supply of a reactive gas at a first flow rate (T_3) and (b) starting a supply of the reaction gas at a second flow rate (T_4) after step (a), and while the supply of the reaction gas at said first flow rate continues, as indicated on page 3, 1st paragraph of the Amendment filed on August 13, 2002.

The Examiner has not provided any reasoning or explanation for finding that the noted portions of the specification and the figures do not support the claims as amended. Thus, Applicants respectfully request reconsideration of the rejection or an explanation as to why the present specification is not considered to support the claimed invention.

II. Response to Claim Rejections Under 35 U.S.C. § 103

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okamoto et al in view of Li et al for the reasons of record. The Examiner agrees that Okamoto et al does not teach or suggest the invention as presently claimed. However, it is the Examiner's position that the claimed features upon which Applicants rely in distinguishing the claimed invention over the prior art is new matter as discussed above.

Applicants respectfully traverse the rejection and submit that the rejection under 35 U.S.C. § 103(a) is improper. It appears as if the Examiner's position is that the claims as amended are allowable over the prior art but that the claims contain new matter, which is improper since it has been established that all elements of a claim must be considered and given weight in an analysis under 35 U.S.C. § 103, including limitations which allegedly do not find

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support in the specification as filed. *See* MPEP § 2143.03 citing *Ex parte Graselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem* 738 F.2d 453 (Fed. Cir. 1984). Therefore, since the Examiner admits that Okamoto et al does not teach all elements of the invention as presently claimed, since Li et al does not remedy the deficiencies of Okamoto et al, and since the Examiner has not cited references that teach or suggest the claimed invention as a whole, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

III. Request for Interview

Applicants respectfully request an interview with the Examiner to discuss the application. The Examiner is requested to contact the undersigned, Jennifer Hayes, at (202) 775-7533 to schedule an interview.

IV. Conclusion

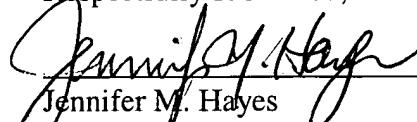
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,


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